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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,347	07/09/2003	Hideo Morimoto	07700.038001	1532
7590	07/07/2004		EXAMINER	
Jonathan P. Osha Rosenthal & Osha L. L. P. 1 Houston Center, Suite 2800 1221 McKinney Avenue Houston, TX 77010			NGUYEN, VINCENT Q	
			ART UNIT	PAPER NUMBER
			2858	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,347	MORIMOTO, HIDEO	
	Examiner	Art Unit	
	Vincent Q Nguyen	2858	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date ____.	6) <input type="checkbox"/> Other: ____.

DETAILED ACTION

Drawings

1. Figures 11 and 12 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Objection

2. What is a detective member (e.g. claim 1, line 2)? Does Applicant mean element 21? Since examiner is unclear of what is the detective member, the recitation such as "a second electrode arranged between the detective member and the first electrode" is confusing. For example, if E21 is read as detective member, E1 is first electrode, and E2 is second electrode, how come the second electrode (E2) arranged between E21 and E1?

Appropriate correction and/or explanation is required.

For the purpose of examination, the examiner assumes that the electrode opposite to E21 (The moveable) is detective member. Thus, E2 is substantially between the moveable and E1.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Pertinence to the discussion of the objection above, claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as

being unpatentable over claims 1-4 of copending Application No. 10/616-352. Although the conflicting claims are not identical, they are not patentably distinct from each other because, except for the arrangement of the second electrode, which is not displaced until the detective member is displaced, the capacitance sensor in the application (This Application, the 10/616-347, herein after referred to as 347) is identical to the capacitance type sensor recited in the Application No. 10/616-352. Although the 347 does not recite a specified space is defined between the detective member and the second electrode, every capacitor must have a distance ("a specified space") between the electrodes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Morimoto et al. (6,373,265).

Regarding claim 1, Morimoto et al. discloses capacitance type sensor comprising (Figures 2-3, 15), a detective member (Dz), a first electrode (Dx) being opposite to the detective member (Dz), a second electrode (Dy) arranged between the detective

member (Dz) and the first electrode (Dx+ and Dx-) and constituting capacitance elements with the first electrode (Dx), the second electrode (Dy) being "displaceable" in a same direction as the detective member (Dz) when the detective member is displaced, and a substrate (1) having flexibility (Column 1, lines 47-67, column 2, lines 12-21) on which the first electrode (Dx) and the second electrode (Dy) are both arranged, wherein the capacitance type sensor is capable of recognizing the displacement of the detective member on the basis of a detection (Column 5, lines 64-67, column 6, lines 1-18), using a signal input to the first electrode, of a change in capacitance value of the capacitance element caused by a change in distance between the first electrode and the second electrode (Figures 3-6).

Regarding claim 2, Morimoto et al. discloses the first electrode (Dx) and the second electrode (Dy) are both arranged on one side of the substrate (1).

Regarding claim 3, Morimoto et al. discloses a supporting member (20) for supporting the detective member (Dz) and the substrate (1) separately.

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Q Nguyen whose telephone number is (571) 272-2234. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (571) 272-2233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vincent Q Nguyen
Patent Examiner
Art Unit 2858

V. Nguyen

July 3, 2004